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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,915	11/16/2000	Toshiyuki Moritsu	ASA-945	2987

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MATTINGLY, STANGER & MALUR, P.C.
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ALEXANDRIA, VA 22314

EXAMINER

WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/712,915

Applicant(s)

MORITSU ET AL.

Examiner

Jalatee Worjloh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-10, 12-21 and 29-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-21 and 29-42 is/are allowed.
- 6) ☒ Claim(s) 2-10 and 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 25, 2004 has been entered.

2. Claims 2-10, 12-21, and 29-42 have been examined.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 7-10 and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6061792 to Simon.

Simon discloses creating a hash value of description data containing a description content about said commodity or service having been transferred between the concerned parties before concluding said contract and an electronic signature proving that both or either the concerned

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parties has created or accepted said description content (see col. 5, lines 1-67), inserting said hash value in contract data containing said contract content therein, appending respective electronic signatures of the concerned parties to said contract data containing said contract content and said hash value and storing said contract data containing said electronic signatures in at least one system of the concerned parties and said third party (see col. 6, lines 61-67; col. 7, lines 1-10).

Referring to claims 8-10, Simon discloses a processing unit (i.e. consumer PC) for creating data string determined with regard to description data containing a description content about a commodity or service and an electronic signature for providing that both or either of the concerned parties has created or accepted said description content, said description data having been transferred between the concerned parties about said contract before concluding said contract and another processing unit (i.e. merchant PC) making contract data have correspondence relationships with said description data by using said data string, said contract data including said contract content and respective electronic signatures of the concerned parties, and for storing said contract data and said description data thus having the correspondence relationships in a storage unit (see col. 5, lines 1-67; col. 6, lines 61-67; col. 7, lines 1-10); wherein said data string is a hash value of said description data; wherein said data string is said description data per se (see col. 4, lines 20-24; col. 5, lines 36-39).

Referring to claim 12, Simon discloses another processing unit for making a description processing program for describing said contract content on an electronic contract document about said contract have correspondence relationships with said contract data (see col. 4, lines 9-14).

Referring to claim 13, Simon discloses a storage unit (see col. 3, lines 55-57), stores description data containing a description content about said commodity or service having been transferred between concerned parties about said contract before concluding said contract, said description data being created in both or either of system of the concerned parties and containing electronic signatures of both or an electronic signature of either of the system of the concerned parties about said description content (see col. 2, lines 35-47), and if said contract is concluded, stores contract data containing said contract content, said contract data being created in both or either of system of the concerned parties and containing respective electronic signatures of the concerned parties about said contract content (see col. 6, lines 61-67; col. 7, lines 1-10); and both or either of the systems of the concerned parties making said description data and said contract data have correspondence relationships to each other by using a data string with regard to said description data (see col. 5, lines 1-49).

Referring to claim 14, Simon discloses a process for creating data string determined with regard to description data containing a description content about a commodity or service having been transferred between concerned parties about a contract before concluding said contract and data for proving that both or either of the concerned parties has created or accepted said description content (see col. 5, lines 1-67), and a process for making contract data containing a contract content about provision of said commodity or service and said description data have correspondence relationships to each other by using data string, said contract containing respective electronic signatures of the concerned parties, and for storing said contract data and said description data thus having correspondence relationships in a storage unit (see col. 7, lines 1-10).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2–5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. in view of US Patent No. 6061792 to Simon.

Walker et al. disclose receiving a question or request (i.e. “CPO”) for said commodity or service from a system of a covenantee (i.e. “buyer”) who intends to conclude said contract through a network (see col. 8, lines 44-49), appending to a response to said question or request, in a system of said covenanter (i.e. “seller”), a covenanter’s electronic signature proving that said covenanter created said response, sending said response containing said covenanter’s electronic signature from the system of said covenanter to said covenantee through the network, storing said response containing said covenanter’s electronic signature in at least one system of said covenanter, said covenantee, and a third party, if said contract is concluded between said covenanter and said covenantee, creating, in at least one system of said covenanter, said covenantee and said third party, an electronic contract document bound to said response containing said covenanter’s electronic signature with a data string determined with regard to said response containing said covenanter’s electronic signature (see col. 19, lines 14-67). Walker et al. do not expressly disclose said electronic contract document containing said covenanter’s

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electronic signature and a covenantee's electronic signature and storing, in at least one system of said covenanter, said covenantee and said third party, said electronic contract document bound to said response containing said covenanter's electronic signature. Simon discloses said electronic contract document containing said covenanter's electronic signature and a covenantee's electronic signature and storing, in at least one system of said covenanter, said covenantee and said third party, said electronic contract document bound to said response containing said covenanter's electronic signature (see col. 6, lines 61-67 and col. 7, lines 1-10). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Walker et al. to include said electronic contract document containing said covenanter's electronic signature and a covenantee's electronic signature and storing, in at least one system of said covenanter, said covenantee and said third party, said electronic contract document bound to said response containing said covenanter's electronic signature. One of ordinary skill in the art would have been motivated to do this because it provides legitimate proof that both parties agree to the terms and conditions.

Referring to claim 3, Walker et al. disclose a response containing said covenanter's electronic signature (see col. 19, lines 14-44). Walker et al. do not expressly disclose the response includes said covenantee's electronic signature proving that said covenantee has agreed with said response. Simon discloses the response containing said covenanter's electronic signature includes said covenantee's electronic signature that said covenantee has agreed with said response (see col. 6, lines 61-67 and col. 7, lines 1-10). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Walker et al. to include the step wherein the response containing said covenanter's electronic

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signature includes said covenantee's electronic signature that said covenantee has agreed with said response. One of ordinary skill in the art would have been motivated to do this because it provides legitimate proof that both parties agree to the terms and conditions.

Referring to claim 4, Walker et al. disclose if a question or request (i.e. "CPO") for said commodity or service is received from a covenantee (i.e. "buyer") who intends to conclude said contract outputting a response (i.e. "counteroffer") to said question or request to a system of said covenantee from a system of said covenantor (see col. 8, lines 42-49; col. 9, lines 45-50), if the system of said covenantor obtains, in response to the response thus output, a new response (i.e. response to counteroffer) containing an electronic signature of said covenantee from the system of said covenantee, thereby creating, in the system of said covenantor, an electronic contract between said covenantor and said covenantee about said contract, said contract containing an electronic signature of said covenantee's (see col. 23, lines 6-17; col. 22, lines 47-51; col. 19, lines 40-44). Walker et al. do not disclose the contract for the new response includes the electronic signature of said covenantor's. Simon discloses the electronic contract including the signatures of both the covenantee and covenantor (see col. 6, lines 61-67 and col. 7, lines 1-10). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Walker et al. to include the electronic contract for the new response includes the electronic signature of the covenantee and covenantor. One of ordinary skill in the art would have been motivated to do this because it provides legitimate proof that both parties are agree to the terms and conditions.

Referring to claim 5, Walker et al. disclose appending, in the system of said covenanter, an electronic signature of said covenanter to the response to be outputted to the system of said covenantee (see col. 19, lines 14-44).

Referring to claim 6, Walker et al. disclose sending a question or request (i.e. "CPO") for provision of said commodity or service from a provider for said commodity or service through a network (see col. 8, lines 44-49), receiving a response to said question or request from said provider through the network, and if a contract for provision of said commodity or service is concluded between said provider and said person who accepts said commodity of service, making an electronic document on said contract have correspondence relationships to said response containing an electronic signature of said provider (see col. 19, lines 14-67). Walker et al. do not expressly disclose appending and electronic signature of said person who accepts said commodity or service to said response and then sending said response to said provider through the network, storing said response with the electronic signature of said person who accepts said commodity or service appended thereto in at least one system of said provider, said person who accepts said commodity or service and a third party, and an electronic contract document containing an electronic signature of said person by using a data string determined with regard to said response containing said person's electronic signature, storing the electronic document and said response containing the electronic signature of said person thus having correspondence relationships in at least one system of said provider, said person and said third party. Simon discloses appending and electronic signature of said person who accepts said commodity or service to said response and then sending said response to said provider through the network, storing said response with the electronic signature of said person who accepts said commodity or

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service appended thereto in at least one system of said provider, said person who accepts said commodity or service and a third party, and an electronic contract document containing an electronic signature of said person by using a data string determined with regard to said response containing said person's electronic signature, storing the electronic document and said response containing the electronic signature of said person thus having correspondence relationships in at least one system of said provider, said person and said third party (see col. 6, lines 61-67 and col. 7, lines 1-10). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Walker et al. to include the step of appending and electronic signature of said person who accepts said commodity or service to said response and then sending said response to said provider through the network, storing said response with the electronic signature of said person who accepts said commodity or service appended thereto in at least one system of said provider, said person who accepts said commodity or service and a third party, and an electronic contract document containing an electronic signature of said person by using a data string determined with regard to said response containing said person's electronic signature, storing the electronic document and said response containing the electronic signature of said person thus having correspondence relationships in at least one system of said provider, said person and said third party. One of ordinary skill in the art would have been motivated to do this because it provides legitimate proof that both parties agree to the terms and conditions.

Allowable Subject Matter

7. Claims 15- 21, 29-42 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306, 703-746-9443 for Non-Official/Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450***

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, V.A., Seventh floor receptionist.



**JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**

June 2, 2004